



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER OF PATENTS AND TRADEMARKS  
Washington, D.C. 20231  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/811,199	03/16/2001	Mohsen S. Marzouk	FIB 0094 PA	6667

23368 7590 02/21/2002

KILLWORTH GOTTMAN HAGAN & SCHAEFF, LLP  
ONE DAYTON CENTRE, SUITE 500  
ONE SOUTH MAIN STREET  
DAYTON, OH 45402-2023

EXAMINER

MICHL, PAUL R

ART UNIT	PAPER NUMBER
----------	--------------

1714

5

DATE MAILED: 02/21/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

Applicant(s)

Examiner

Group Art Unit

— The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address —

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE THREE MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- ☐ Responsive to communication(s) filed on \_\_\_\_\_
- ☐ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- ☒ Claim(s) 1-15 is/are pending in the application.
- ☐ Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- ☒ Claim(s) 1-15 is/are rejected.
- ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- ☐ Claim(s) \_\_\_\_\_ are subject to restriction or election requirement

## Application Papers

- ☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119 (a)-(d)

- ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119 (a)-(d).
- ☐ All ☐ Some\* ☐ None of the:
  - ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_
  - ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a))

\*Certified copies not received: \_\_\_\_\_

## Attachment(s)

- ☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_
- ☒ Notice of Reference(s) Cited, PTO-892
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Interview Summary, PTO-413
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Other: \_\_\_\_\_

Office Action Summary

Art Unit 1714

The following is a quotation of the appropriate paragraphs of 35 U.S.C. § 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The following is a quotation of 35 U.S.C. § 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-15 are rejected under 35 U.S.C. § 102(b) as being anticipated by Shimizu or Leveskis or Brusky or Sekine or Parish.

Claims 1-15 are rejected under 35 U.S.C. § 102(e) as being anticipated by Patel. Applicants' claims 1-7 are directed to a composition comprising ester, peroxide and solvent. Claims 8-15 are directed to a method of making a composition comprising

peroxide and solvent by mixing peroxide with solvent. All of these references disclose compositions comprising ester, methylethylketone peroxide, and solvent. Applicants' claims lack novelty. Shimizu discloses solvent in claim 4 and methylethylketone peroxide in claim 6. Leveskis discloses methylethylketone peroxide, solvent, and ester in the Abstract. Brusky discloses solvent in claim 12 and peroxide in claim 14. Brusky discloses a number of esters in Table 2. Sekine discloses methylethylketone peroxide and polyester in claim 2. In claim 2 the hydroxyethyl methacrylate qualifies as both solvent and ester within applicants' claims. In column 12, lines 24 and 25 Sekine discloses peroxide and dimethyl phthalate. The dimethyl phthalate qualifies as solvent and ester within applicants' claims. Parish discloses esters in claims 4 and 5. Parish discloses methylethylketone peroxide in claim 12 and acetone and ethyl acetate solvents in claim 13 at column 8, lines 66 and 67. Patel discloses esters in claims 2, 5, 6 and 9. Patel discloses methylethylketone peroxide in claim 13. Patel discloses dibutyl phthalate in claim 15 which is an ester. Patel discloses solvents in claims 19 and 20. Patel discloses ethyl acetate solvent in claim 26.

Claims 1-15 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Shimizu or Leveskis or Brusky or Sekine or Parish or Patel. It would be obvious to one of ordinary skill in

Art Unit 1714

the art to formulate compositions comprising ester, methylethylketone peroxide, and solvent such as an acetate solvent in any of these references. The motivation is that these references clearly teach the formation of compositions comprising ester, peroxide, and solvent.

Claims 1-15 are rejected under 35 U.S.C. § 112 second paragraph for failure to particularly point out and distinctly claim what applicants consider to be the invention. The phrases "ester" and "solvent" fail to particularly point out and distinctly claim what applicants consider to be the invention because these terms are not mutually exclusive from one another. Applicants consider the invention to be a three component composition. However, the word "ester" encompasses ester solvents and the word "solvent" also encompasses ester solvents. Therefore, when an ester solvent is used as the solvent in the claims, the three component composition becomes only a two component composition comprising peroxide and ester solvent. Applicants do not consider two component compositions to be the invention. Claims 8-15 also fail to particularly point out and distinctly claim what applicants consider to be the invention. Claims 8-15 are method claims. Method claims are characterized by the method steps in the form of verbs. The only method step and the only verb recited in these claims is the step of "mixing". Therefore, claims 8-15 are directed to a method of

Art Unit 1714

mixing peroxide and solvent. The method step of mixing peroxide and solvent forms a composition of peroxide and solvent. Applicants' invention is not merely a method of mixing peroxide and solvent to form a composition of peroxide and solvent. Critical method steps are lacking in claims 8-15.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Paul Michl whose telephone number is (703) 308-2451. The examiner can normally be reached on Monday through Friday from 7:30 A.M. to 4 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan, can be reached on (703) 306-2777. The fax phone number for this Group is (703) 305-5433.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-2351.

PRMichl:cdc

February 14, 2002



**PAUL R. MICHL**  
**PATENT EXAMINER**  
**ART UNIT 156**